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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/034,586

12/27/2001

Tracee E.J. Eidenschink

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09/13/2006

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MINNEAPOLIS, MN 55403-2420

EXAMINER

NGUYEN, VI X

ART UNIT

PAPER NUMBER

3734

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,586

Applicant(s)

EIDENSCHINK, TRACEE E.J.

Examiner

Victor X. Nguyen

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-22 and 24-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-22 and 24-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5, 11-13, 20-22, 24-26 and 28-33 are rejected under 35 U.S.C. 102 (b) as being anticipated by Lundquist (5,329,923).

Lundquist discloses in abstract and figs 3-4, a catheter for use during a surgical procedure on a body, including: an elongate shaft (31) has a lumen (39) which extends therethrough, a core member has proximal and distal end, an inner surface (38) is in fluid communication with the lumen, an outer surface (37), where a raised pattern (41) of generally noncontiguous element (fig. 3) disposes on the outer surface, where the raised pattern further comprises a plurality of bearing points (the two flex portions occur at 41 would permit to have many bearing points when they are bending on an inside radius of each slots. Note that the catheter of Lundquist in figures 3-4 is capable of improving the transmission of torque along the elongate shaft when torqued, and where adjacent raised shapes are separated when the shaft is not being torqued, where at least two adjacent raised shapes move toward one another when the shaft is torqued, and where the catheter is a guide catheter (see col. 9, lines 22-30). Note that the procedure in fig. 3 discloses the raised pattern defines means for improving the transmission of torque along the elongate shaft while under torsion.

Claims 5,12,25,27,32 and 34 are rejected under 35 U.S.C. 102 (b) as being anticipated by Tittel (4,465,482).

Tittel discloses in figs 1-2, a catheter for use during a surgical procedure on a body, including: an elongate shaft has a lumen which extends therethrough, a core member has proximal and distal end, an inner surface (4) is in fluid communication with the lumen, an outer surface (1), where a raised pattern (12) of generally noncontiguous element (fig. 2) disposes on the outer surface, where the raised pattern further comprises a plurality of bearing points (depending upon the direction in which the tube is twisted, the helical slot will be widened or constricted which resulted in having a plurality of bearing points). Note that the catheter of Tittel in figure 2 is capable of improving the transmission of torque along the elongate shaft when torqued, and where adjacent raised shapes are separated when the shaft is not being torqued, where at least two adjacent raised shapes move toward one another when the shaft is torqued, and where the raised elements are diamond-shaped (fig. 2).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-10 and 15-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Lundquist (5,329,923).

Regarding claims 6-7 and 15-16, the recited claims, "the raised pattern is formed by laser ablation or by overmolding" is not given any patentable weight since this is a product by

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process limitations that are not constructed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15. Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made patentable. In Re Klug, 333 f2d 742, 180 U.S.P.Q. 161 (CCPA 1974). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the raised pattern is formed by laser ablation or by overmolding, since a comparison of the recited process with the prior art process does not serve to resolve the issue concerning patentability of the product. Regarding claims 8-10 and 17-19, the recited claims "the raised pattern is formed by hot die casting/embossing or by extrusion" is not given any patentable weight since this is a product by process limitations that are not constructed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15. Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made patentable. In Re Klug, 333 f2d 742, 180 U.S.P.Q. 161 (CCPA 1974). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the raised pattern is formed by hot die casting/embossing or by extrusion, since a comparison of the recited process with the prior art process does not serve to resolve the issue concerning patentability of the product.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Lundquist (5,329,923) in view of Moore et al (4,669,465).

Regarding claim 14, Lundquist is explained as before. However, Lundquist does not disclose the catheter is a balloon catheter.

Moore et al teach the catheter is a balloon catheter (fig. 1 and col. 2, lines 25-27).

It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Lundquist by making the catheter is a balloon catheter as taught by Moore et al in order to create an overall system with added capability into a body lumen.

Response to Arguments

4. Applicant's arguments filed 6/23/2006 have been considered but are moot in view of new ground(s) of rejection. The applicant argues that Lundquist reference fails to teach a raised pattern of generally noncontiguous elements disposed on the outer surface. As claims 5, 12, 25 and 32 are currently written, they can be interpreted broadly that the Lundquist reference at least discloses in figure 4, a slot 41 can be equivalent as a raised pattern of generally noncontiguous elements disposed on the outer surface 37 which would fit the descriptive of the term "raised pattern" as recited. The same argument will apply to the Tittel reference. At best seen in fig. 2, Tittel does disclose a raised pattern 12 of generally noncontiguous element which disposes on the outer surface 1. Accordingly, the above noted reference is still considered to read on the claimed limitations of the claims noted.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

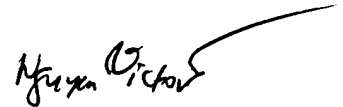
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victor X Nguyen
Examiner
Art Unit 3734



VN
8/24/2006



MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER